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Attorney Docket No. 15722/471CIP

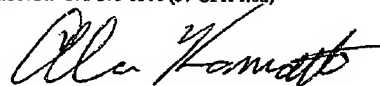
Client Docket No. CFP-1842-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re App : Arlo H. T. Lin : Examiner Alfred Basichas
Serial No. : 10/814,565 : Art Unit 3749
Filed : 03/31/2004 : Confirmation No. 6890
For : Cigarette Lighter with Alarm

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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TO FAX NO.: 571-273-8300 (37 CFR 1.8a)

APPEAL BRIEF

Dear Sir:

In response to the office communication mailed November 13, 2007, appellant wishes to appeal the rejections of the Examiner.

(1) REAL PARTY IN INTEREST

The inventor has assigned the present application to Frederick L. Doob, 70 Mill Creek, Moreland Hills, OH 44022.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF CLAIMS

Claims 10 and 14-18 are allowed. Claim 1 is canceled. Claims 2-9 and 11-13 are rejected under 35 U.S.C. § 103(a) and are being appealed.

(4) STATUS OF AMENDMENTS

All Amendments have been entered. Originally filed claims 1-3 and 10-12 were amended and claims 13-18 were added in an Amendment filed on December 9, 2005.

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Claim 1 was canceled and claim 13 was amended in an Amendment filed October 10, 2006.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

Claim 13 recites a cigarette lighter 10 including a reservoir 12 for storing fuel (page 3, lines 5 and 6); a head 11 formed on the reservoir 12 (page 3, line 7); a valve 13 for releasing the fuel from the reservoir 12 (page 3, line 8); a nozzle 16 put in the head 11 for spraying the fuel from the valve 13 (page 3, lines 9 and 10); an ignition device 15 for igniting the fuel sprayed from the nozzle 16 into a flame (page 3, lines 10 and 11); a cover 21 for covering the head 11 (page 3, line 11); and an alarm 30 (page 3, line 11) for providing only one round of an audible message every time the cover 21 is lifted, with the alarm 30 including a speaker 33 providing the only one round of the audible message (page 1, lines 24-26 and page 2, lines 6 and 7 and lines 22 and 23), with the cover 21 being lifted for an ignition time to ignite the fuel and to use the flame, with the only one round of the audible message being of a duration less than the ignition time.

Claim 10 recites a cigarette lighter 10 including a reservoir 12 for storing fuel (page 3, lines 5 and 6); a head 11 formed on the reservoir 12 (page 3, line 7); a valve 13 for releasing the fuel from the reservoir 12 (page 3, line 8); a nozzle 16 put in the head 11 for spraying the fuel from the valve 13 (page 3, lines 9 and 10); an ignition device 15 for igniting the fuel sprayed from the nozzle 16 (page 3, lines 10 and 11); a cover 21 for covering the head 11 (page 3, line 11); and an alarm 30 (page 3, line 11) for providing only one round of message every time the cover 21 is lifted, with the ignition device 15 including a body 24 (page 3, line 13), a button 26 extending from the body 24 (page 3, line 13), an external button 23 installed on the button 26 (page 3, line 20), and a rod 25 extending from the external button 23 (page 3, line 21), wherein the cover 21 includes, in an edge, a hole 27 for receiving the rod 25 so as to lock the cover 21 in a closed position (page 3, line 26-page 4, line 2).

Specifically, in the preferred form, the cover 21 includes two ears 42 extending from a side. A collar 44 is installed on the head 11. The collar 44 includes two ears 46 extending from a side. The ears 42 are pivotally connected with the ears 46 by a pin 50. The alarm 30 includes a switch 31 installed on the collar 44 between the ears 46, a circuit board 35 put in a container 40 integrated with reservoir 12 and a wire 36 leading to the

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switch 31 from the circuit board 35. The switch 31 is pushed by the ears 42 so that a round of a message is played through the speaker 33 for a duration less than the ignition time.

Additionally, in the preferred form, the ignition device 15 further includes an electrode 28 extending from the body 24 to the vicinity of the nozzle 16. In the body 24 is arranged a circuit from which the electrode 28 extends. When the button 26 is pushed, a voltage is produced by the circuit. Thus, an electric arc appears between the electrode 28 and the nozzle 16 to ignite the sprayed fuel. The external button 23 can be pushed hard so as to push the button 26 in order to ignite the fuel. No matter how many times the external button 23 is pushed hard for ignition, no round of the message will be played since the switch 31 is not connected with the external button 23 in any way.

(6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Are claims 2 and 11-13 unpatentable under 35 U.S.C. § 103(a) as being obvious over Kuriyama (Japanese Patent No. JP11051391) in view of Semenko (U.S. Patent No. 3,816,057) and are claims 3-9 unpatentable under 35 U.S.C. § 103(a) as being obvious over Kuriyama (Japanese Patent No. JP11051391) in view of Semenko (U.S. Patent No. 3,816,057) and in further view of Chen (U.S. Patent No. 6,527,542)? All rejected claims can be grouped together.

(7) ARGUMENT-The admitted deficiencies of Kuriyama are not suggested by Semenko (and/or Chen)

Kuriyama discloses a cigarette lighter 1 including, among other things, a reservoir for storing fuel 17, a head 6 formed on the reservoir, a valve 7a for releasing the fuel from the reservoir, a nozzle 7b put in the head for spraying the fuel from the valve, an ignition device 8 for igniting the fuel sprayed from the nozzle, a cover 4 for covering the head and a visual alarm 23 for providing a visual message every time the cover 4 is lifted. The visual alarm includes a switch 30 for contact with the cover 4 when the cover 4 is lifted. Kuriyama does not specifically recite the message as audible or the claimed duration of the message.

Semenko discloses a cigarette lighter having a cover 36 and "if desired, an audio system for sound pick-up from the film strip" every time the cover is lifted, with the alarm including a speaker 34.

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Examiner Basichas recognizes that Kuriyama does not meet the recitations of the claims as it does not include:

A) the message as audible (with Examiner Basichas relying upon the Simenko reference to meet this deficiency, which for purposes of appeal is not being contested); or

B) the claimed duration (one round as recited in claim 13).

In attempting to fill this admitted deficiency B), Examiner Basichas contends:

As regards having only one round of the audible message, it is a matter of design choice based on esthetic appeal. The particular message and duration is simply a matter of personal preference. In view of the absence of criticality for this particular design, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate it into the invention disclosed by Kuriyama in view of Semenکو, so as to provide for the desired esthetics (emphasis added).

It is respectfully submitted these are not proper grounds for rejection. Specifically, as to design choice, as stated by the Patent Office Board of Appeals in Ex parte Dere, 118 U.S.P.Q. 541 (1957) at page 544:

It will be observed that the last sentence of the above quotation is a concession that the art contains no suggestion of having marked zones of perforation on opposing edges spaced according to the metric or English systems respectively. The examiner, as to this relationship, which is the very thing that yields the useful results already pointed out merely states it:

'is not seen to provide a patentable distinction, being no more than a matter of choice.'

Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a 'choice' available.

In view of the fact that claimed relationship has the useful advantages already Enumerated, we cannot agree with this undocumented statement.

Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AIPLA Bulletin:

Are the Examiners even attempting to search for what they regard as "mere matters of design choice." Federal Circuit decisions such as In re Newell, No. 891332 (Fed. Cir. Dec. 12, 1989) and In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986) show that the Federal Circuit has recognized the problem and will

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insist on the citation of relevant art. A rejection based on "mere design choice" should be supported by the prior art.

Particularly, as set forth in In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as "prior art." Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

As set forth in the Background of Invention of the present application that a repeating message is annoying when several attempts are made before ignition is achieved, the claimed relationship of the present invention is advantageous. Thus, the failure of the Examiner to in any way support that any other "design choice" or that any other "personal preference" as to duration is suggested by the prior art is a clear indication that the present invention is not obvious in view of the prior art.

Further, as to being critical, the Board of Appeals in Appeal No. 94-4450 in Application No. 07/945,247 stated:

The limitations in appellant's claims cannot simply be dismissed "since no showing of criticality has been made" (answer, page-2 and final rejection, page 3). It is not a prerequisite to patentability that the limitation in a claim be "critical". See W.L. Gore & Associates, Inc. vs. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Examining the Gore decision, the Court of Appeals for the Federal Circuit held:

Garlock's appeal argument that the '390 claims are invalid because the recited minimum matrix tensile strengths are not "critical" is without merit. A claim to a new product is not legally required to include critical limitations. (citation omitted)

Thus, even if the limitations are not critical as contended by the Examiner, does not mean the present invention is obvious over the prior art.

In reply to the above showing, the examiner stated in its entirety:

Applicant's arguments with respect to the claim have been considered but are not deemed persuasive. It appears that applicant is arguing that the rejection is improper because the examiner has required a showing of criticality to overcome the obviousness rejection based on design choice. The examiner disagrees with applicant's position (emphasis added).

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However, the Examiner has failed to clearly indicate the points of disagreement. It would be assumed that if the prior art in any way suggested that a "choice" of duration existed or that duration could be a "personal preference," the Examiner would have answered the substance of applicant's argument in a manner required by MPEP § 707.07(b).

Additionally, the Examiner is improperly utilizing hindsight in first selecting elements from each of the individual patents (while discarding the other elements taught therein) and then combining those elements in a way which is not suggested by the prior art but is motivated only by the attempt to meet the recitations of the claims.

Specifically, the CAFC in Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 56 USPQ2d 1065 (2000) stated:

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight." Id.

"Obviousness cannot be established by combining the teachings of the prior art to produce a claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir.1984). Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "[d]efining the problem in terms of its solution reveal improper hindsight in the selection of the prior art relevant to obviousness," Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 13 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann, 730 F.2d at 1462, 221 USPQ at 488).

The absence of a convincing discussion of the specific sources of the motivation to combine the prior art references, particularly in light of the strength of prior art teaching away from the use of the Houghton process, is a critical omission in the district court's obviousness analysis, which mainly discusses the ways that the multiple prior art references can be combined to read on the claimed invention.

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Turning to the present application, the Examiner concedes that Kuriyama does not specifically recite that the message is of a length of one-round as in the present application. Semenکو states in the Background of the Invention that "match book covers are relatively short lived and inasmuch as many smokers utilize an automatic cigarette lighter, the impact of such advertising or information material is not as great as it could be." (Col. 1, lines 11-14). Semenکو further states that another object of the invention is to provide "repetitive long-lasting information" (Col. 1, lines 46-48) or material to the smoker whether it be advertising or health facts graphics or both." It may be obvious to modify the invention in Kuriyama utilizing Semenکو to provide repetitive long-lasting information for the smoker. It would not be obvious, as in the present invention, to decrease the time that the audible message was available to the consumer as neither reference provides any suggestion of a desirability to do so. The absence of any discussion of the specific sources of motivation to combine the prior art and in light of both pieces of prior art teaching away from the recited invention is a critical omission in the Examiner's obviousness analysis for the reasons set forth in Ecoclolem.

(8) CONCLUSION

Therefore, since the claims of the present invention have been shown to include limitations directed to the features of applicant's cigarette lighter with alarm which are neither shown, described, taught nor alluded to in any of the references cited by the Examiner and by the applicant, whether those references are taken singly or in combination, the Board of Appeals is requested to reverse the rejections of the Examiner and allow claims 2-18 of the present application and pass this application to issue.

Respectfully submitted,

Arlo H. T. Lin



Alan D. Kamrath, Reg. No. 28,227
KAMRATH & ASSOCIATES, P.A.
Attorneys for Applicant
4825 Olson Memorial Highway, Suite 245
Golden Valley, MN 55422
Tel: (763) 746-1599
Fax: (763) 746-8125